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IN THE

# SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1953

## NO. 425

OLIVER UNITED FILTERS, INCORPORATED,
*Petitioner,*

*vs.*

HAROLD F. SILVER (an individual),
*Respondent.*

## BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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### OPINIONS BELOW.

The opinion of the District Court is reported in 103 Fed. Sup. 935.*

The opinion of the Court of Appeals for the Tenth Circuit (R. 357) is reported in 206 Fed. (2d) 658.

### JURISDICTION.

The jurisdiction is invoked by petitioner under Section 28 U.S.C. 1254 (1).

*Respondent regrets that for some reason unknown to him, the decision of the District Court is not included in the printed record, although, the record does include the findings of fact and conclusions of law (R. 25-35). As the careful and detailed consideration given to the facts by the trial judge is reflected in the opinion itself, the Court's attention is respectfully invited to the published decision.

## PRELIMINARY STATEMENT.

This is an ordinary patent case involving only factual issues bearing on validity and infringement. There are no other issues.

There are two patents, Nos. 2,390,131 and 2,468,720, both of which were granted to respondent, Harold F. Silver, on inventions made by him. Patent No. 2,390,131 relates to a process for diffusing sugar from sugar beets, and Patent No. 2,468,720, which was copending in the Patent Office with the application for the first patent, relates to a machine for diffusing sugar from sugar beets, and in addition a certain improvement on the process of the first patent.*

At the present time, there is no conflict of decisions among the Circuit Courts and the record affirmatively shows that the sugar beet industry is not confined to the Tenth Judicial Circuit. Petitioner's infringing machine (referred to herein as "the Morton Battery"), was made and installed for use in the State of California (R. 76-77) and respondent, Silver, manufactured and sold his machine in Colorado (R. 50-51) and installed the same for use in various States throughout several Judicial Districts.

All arguments on the merits which petitioner now makes were fully briefed and argued by it both before Judge Knous in the District Court and before the Court of Appeals for the Tenth Circuit.

The Circuit Court approved Judge Knous' finding that Silver—

> "had given to the beet sugar industry, for the first time in its history, a continuous diffuser which works."

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*Patent No. 2,390,131 will be referred to herein as the "first patent", and Patent No. 2,468,720 will be referred to herein as the "second patent".

and also that—

> "if after almost one hundred years all the prior efforts to overcome the difficulties of diffusion in the industry failed, it cannot be said that Silver's efforts were only the result of mechanical skill in assembling known elements." (R. 364-365)

The Circuit Court also approved Judge Knous' finding that Silver's patents disclose—

> "new combinations in the process and apparatus which employ a new mode of operation to produce a new and improved result over anything existing in the prior art." (R. 365)

By concurrent findings, it was also established that Silver's outstanding inventions were copied by petitioner. (R. 33-34, 368)

These findings are supported by the voluminous record, including highly technical testimony by practical experts in the art called by both parties. They relate to the chemical and physical behavior of large masses of beet stock submerged in diffusion baths while subjected to mechanical handling procedures. The problems not only involved the maintenance of concentration relationships between the sugar inside and outside of the beet stock, but the physical disposition and character of the beet stock itself, with avoidance of matting and the preservation of the undamaged cellular structure as is required to overcome the tendency to dam up and flood the machinery, as well as to provide good diffusion relationships between the beet stock and its surrounding liquid. (R. 49, 54-65)

## THE PATENT LAW ISSUES.

Not one of the nine questions presented by petitioner on patent issues (Petition p. 46, 47; also petitioner's brief p. 81, 82) merits the attention of this Court.

*All four judges of both lower courts* found that Silver invented a novel beet diffusing process and machine, patentable over all prior art, and that petitioner's Morton Battery infringed the second patent, and its use infringed both the first and second patents. (R. 34-35, 367)

Furthermore, both lower courts agreed that claims 1, 2, 4, 6, 8, 11, 12, and 13 of Silver patent No. 2,390,131, and claims 2, 3, 4, 6, 7, 9, 10 and 11 of Silver patent No. 2,468,720 were valid and infringed. (R. 34, 368)

## NO QUESTION OF PUBLIC INTEREST IS PRESENTED.

All issues of invention, anticipation, and infringement were settled by concurrent findings of the lower courts. Petitioner's own summary (Petition p. 46-51, incl.) reveals that anticipation and infringement are the basic issues on which review is sought.

Such a controversy presents no questions having the general public interest which warrant the grant of a writ of certiorari.

## STATEMENT OF FACTS.

The concurrent and detail findings of the District Court and the Court of Appeals on the patent issues establish that:

1. Silver invented the first continuous diffusing process and machine for treating sugar beets that actually worked, and that he did so notwithstanding the unsuccessful and numerous efforts of the prior art workers extending back for a period of almost one hundred years.
2. The novel features of the Silver inventions were properly claimed, and the patents are valid.

3. The novel process and machine invented by Silver were deliberately appropriated by petitioner, and the essential features of the two inventions, respectively, were embodied in the Morton Battery and the use thereof.

In large measure, the significant portions of the findings of the two lower courts resulted from careful analysis and appraisal of an extensive and technical record, and nowhere have such findings been adequately dealt with or explained by petitioner.

We shall discuss the record on the above three points in the stated order and shall point out that petitioner is seeking nothing more than a further review of factual matters which already have been completely and properly disposed of.

We shall further show that petitioner does not address itself to the true issues presented by the combination patents here under consideration, but, rather, seeks to dissect the inventions into their elemental parts and to defeat the patents element by element. In the published decision of the District Court, Judge Knous said (p. 938):

> "• • • Oliver dissects Silver's inventions into their elemental parts and proceeds to attack them piecemeal on the basis that such elemental parts, standing alone and separately, are not in themselves new."

**1. Silver Made Meritorious Inventions which Supplied a Long Felt Want in the Art, and which were not Anticipated by the Prior Art.**

A brief review of the concurrent findings of the lower courts with respect to the origin of Silver's inventions will be of assistance in understanding their nature.

Prior to Silver's work, the only commercially successful process and apparatus known to the industry was the "Robert Battery". That battery is a batch-type apparatus consisting of a series of separate but connected stationary tanks into which the beet stock or cossettes are introduced. Although reliable, this type of battery is cumbersome and comparatively inefficient. It requires relatively a large number of men to operate it and the water content of the juice is high. Its long use, however, had demonstrated to the prior workers the value of a countercurrent system of flow of solids and liquid in conjunction with mechanical handling procedures which did not damage the cossettes or impair the diffusing activity. The problem remained, however, as to how the cossettes could be handled mechanically for *continuous* treatment, with the elimination of the disadvantages of batch treatment and the attendant uneconomic consequences in efficiencies of high labor costs and high fuel consumption required for the removal of the high water content of the juice. (R. 27-28, 359-360)

The first efforts of the prior workers were those attempting mechanical conveyance of cossettes and movement of the juice through a straight countercurrent system. Due to the pulpy and gelatinous nature of the beet stock, these efforts were unsuccessful as the stock would dam up the equipment, prevent countercurrent movement of the juice, and flood the machine. Many workers concluded that the problem of damming and flooding presented by the countercurrent machine was impossible of solution, and though efforts to succeed in that direction have continued, it was proposed many years ago to modify the flow to provide a countercurrent passage of the cossettes and juice through the system as a whole, but to alter the old practice to the extent of providing in conjunction therewith a concurrent flow of stock and juice in each separate cell or tank, re-

spectively. Efforts to provide a satisfactory countercurrent-concurrent process likewise failed, however, not because the mechanical handling was not satisfactory nor that damming and flooding were not prevented, but because of subtle effects produced by such flow systems upon the diffusing activity. Such systems inherently involved in the transfer of cossettes from one cell to the next, the deposit of associated juice of much higher concentration than that of the liquid into which the cossettes are deposited. This feature defeated all attempts of prior workers with such persistence that the workers who sought a solution to the problem were prompted to abandon the countercurrent-concurrent principle and direct their efforts once more to the straight countercurrent system as the one which in all probability offered the greatest hope of success. (R. 28, 360)

In summarizing the findings of the District Court, the Circuit Court made the following statement on the prior state of the art:

> "When Silver entered the field, the 'Robert Battery' was being used exclusively in the United States and Canada. It is the only method in use today except in those factories which are now equipped with the Silver machine and two which use the accused machine. It had been the predominating view of technical workers that any countercurrent system would not succeed. The straight countercurrent method presented a problem of clogging and mutilation of the cossettes which could not be overcome. The countercurrent-concurrent system eliminated the clogging difficulties but created other deficiencies. The density of the cossettes varies, some floated, and some sank in the fluid. The fact that the cossettes and juice flowed concurrently resulted in a less effective washing and inefficient diffusion. When transferred from one cell to another the cossettes carried with them a substantial quantity of juice which was of a higher concentration of sugar than that

of the juice in the cell into which they were being transferred and the equality of sugar content in the beets and juice tended to defeat diffusion. Some inventors sought unsuccessfully to overcome this with presses and other methods of enforced separation.[3] After many attempts, the problem of producing a commercially successful continuous diffusion system remained wholly unsolved" (R. 360). (In the decision, the footnote identified five of the prior art patents.)

**Silver's Inventions**: It was at this point in the development of the art that Silver entered the field and solved the problem. He first had to choose between the two types of systems and decide whether he would undertake to perfect a straight countercurrent system or a countercurrent-concurrent system. Upon analyzing the defects of both, he detected and analyzed the major difficulty involved in the latter, and then proceeded to devise a countercurrent-concurrent system that actually worked on a highly successful basis. (R. 44)

In concurrence with the District Court, the Circuit Court described Silver's inventions as follows:

> "We come then to the question of what Silver has contributed to the art that constitutes patentable inventions. He first undertook to analyze and discover why the countercurrent-concurrent type of diffusion system had not been successful. The claimed patentability lies in the method or process by which the beet stock is made to move in the alternate downward and upward course of travel to cause an enforced submergence in the countercurrent of the juice in a manner to effect an alternate washing, draining, and transfer from one cell to the next without mutilating the cossettes as they move through the course of treatment. The application of force or pressure to the cossettes is avoided so that they remain unmutilated and in good condition for diffusion activity and thereby retain

most of the impurities. In this draining process the juice of high concentration, including the diffusion resistant surface films found on the cossettes, is removed and it returns to the cell of relatively high juice concentration from which it was taken. The district court found that the enforced submergence of the cossettes from above the diffusion liquid with a downward and upward movement while submerged, followed by a drainage of the liquid in that cell before transfer to the next cell made Silver's machine different from those disclosed by the prior art.[4]" (R. 362) (In the decision, the footnote quoted Findings of Fact of the lower court 14 to 17, inclusive (R. 29, 30).)

**Commercial Success**: The patented inventions have been highly successful and have been extensively adopted by the sugar beet industry (R. 30, 364).

> "After making his inventions, Silver manufactured and sold to the beet sugar producers in the United States and Canada, continuous diffusion devices which were highly successful in actual practice and which were made in accordance with the disclosures and claims of his said two patents. The devices so made and sold employed the processes defined by the process claims in suit of said two patents No. 2,390,131 and No. 2,468,720, and the devices so made and sold embodied the structural elements constituting the combination defined by the apparatus claims in suit of said Letters Patent No. 2,468,720. Silver installed sixteen commercial units at an average cost of $250,000.00 each, each of which has effected great savings in the cost of operation and reduction in the loss of sugar." (Finding No. 18, R. 30)

The Circuit Court, in recognition of commercial success, stated as follows:

> "The parties here concede that the problem confronting the workers in the art was difficult and that the need

of the device long existed. The fact that Silver has contributed substantially to the solution of the problem is inescapable. He has given to the beet sugar industry, for the first time in its history, a continuous diffuser which works. Surely, if after almost one hundred years all the prior efforts to overcome the difficulties of diffusion in the industry failed, it cannot be said that Silver's efforts were only the result of mechanical skill in assembling known elements." (R. 364-365)

**2. The Patents Are Valid and Have Been Properly Construed.**

At the trial, the petitioner strenuously insisted that the respondent's inventions were restricted to vertically disposed U-shaped cells of the type illustrated in the drawings of the patents. In petitioner's attempt to escape liability as an infringer, it showed that the accused Morton Battery had cells of horizontal disposition and, as horizontally disposed cells were old in the prior art, it contended, first, that Silver's patents were restricted by file wrapper estoppel to vertically disposed cells, and, secondly, that on that account the Morton Battery followed the prior art and did not embody either of Silver's inventions.

**There Is No File Wrapper Estoppel**: In passing upon this point, the District Court in its decision stated:

> "A careful study of the full text of the statement in the file wrapper, which is too lengthy to include in this memorandum, convinces the Court that the words 'alternate upward and downward courses', stressed by Oliver, when used in context and considered in relation to the remainder of the statement, refers to the upward and downward coursing of the cossettes and liquid as a procedural step and were not intended to refer to the structural features of the apparatus in which the process was to be carried on. This construction is supported by the circumstance that in his first patent Silver specifically states that his process

'also may be performed in cells disposed horizontally' as well as in the vertical cells illustrated.

"In addition, when it is considered that prior art patents showed constructions having cells both horizontally and vertically disposed, it cannot well be said that the Patent Office did not allow Silver's claims on any assumption that the claims had to be limited to vertically disposed cells in order to avoid the prior art." (District Court's Decision p. 941)

The same finding is included in the record (Finding No. 27, R. 32-33). In concurring, the Circuit Court said:

"It seems quite clear that this is not what the patent office had in mind when the claims were rejected, as such cells and conveyors were disclosed in the Olier, Rak and Krauss patents, and if it had been the intention of Silver and the patent office to limit the process to vertically disposed cells, the claim would have been disallowed because of the teachings of those patents.

"The language cited is found in the process claims and refers to the movement of the cossettes through the diffusion fluid in each stage of the process. Its reference is not to any particular mechanism or disposition of mechanism. In his first patent specification Silver said in referring to the vertical disposition of the cells, 'While this is a preferred arrangement, it will be understood that the process also may be performed in cells disposed horizontally with a positive or gravity circulation of liquid employed'." (R. 367)

**There Is No Double Patenting**: In both courts below, the petitioner strenuously urged that the process claims of the second patent were invalid for double patenting. In concurring with the District Court in its finding, the Circuit Court said:

"The application for Patent No. 2,468,720 was pending when Patent No. 2,390,131 was issued. If the second

application or patent discloses or claims matters distinct from and not included in the first patent or application, it is patentable even though the applications are co-pending. In other words, if the second Silver patent defines a process or apparatus different from the discoveries of the first patent, it does not constitute double patenting even though it relates to the same invention." (R. 368-369)

**Inventions As Claimed Avoid the Prior Art:** By concurrent decisions, the lower courts have held that the Silver inventions are valid combinations and that whereas the steps of the processes and the elements of the machine may be found separately in different patents, when considered as a whole the combinations claimed are clearly patentable. In confirming the findings of the District Court, the Circuit Court summarized the relationship of the claimed inventions to the prior art as follows:

"Oliver cites a number of patents which it is urged anticipated Silver's inventions. We need not discuss the prior art patents in detail as none of them taught a combination of steps which solved the problem of continuous diffusion. This defense is limited to eight patents, namely, 755,546 (U.S.) Rak, March 22, 1904; 1,006,311 (U.S.) Steffen, October 17, 1911; 1,492,656 (U.S.) Turrentine, May 6, 1924; 1,523,277 (U.S.) Olier, January 13, 1925; 510,642, (French) Dobler, September 10, 1920; 592,983 (French) Gazagne, May 13, 1925; 558,547 (German) Neufeldt, September 8, 1932; 157,710 (Austrian) Krauss, January 10, 1940. We agree with the trial court that the claims of the two Silver patents in suit were not anticipated by any one or more of these prior art patents. Rak, Steffen, Turrentine, Neufeldt and Krauss provide for a countercurrent-concurrent flow system but each employs an enforced separation of juice from the cossettes between each treatment stage with the use of presses, centrifuges or vacuum filters. These processes have a tendency to destroy the cellular structure

of the cossettes and to defeat diffusion. Gazagne shows a countercurrent-concurrent system with a series of troughs arranged one above the other. The cossettes start at the top and pass downwardly through the troughs by gravity. The juice is forced upward by ejectors. There is no drainage of the cossettes as contemplated by the Silver machine, and the ejectors would cause foaming which would defeat the operation. The Olier and Dobler patents show straight countercurrent flow systems and do not teach the countercurrent-concurrent method disclosed in the Silver machine. No successful machine or apparatus was ever manufactured under these patents and no worker in the prior art before Silver, ever devised a successful combination of the teachings of the prior art. Before declaring Silver's claims patentable, the patent office gave close and careful scrutiny to all the cited patents except Dobler, and recognized the principles which they taught and which were used by Silver in his combination. This creates a presumption of priority and novelty" (R. 365-66).

Not one of the prior art patents achieved the combination of the Silver inventions. Some showed only straight countercurrent systems and whereas others disclosed countercurrent-concurrent processes and machines, each of them failed to understand and solve the problem. The latter taught the use of either mechanical handling means productive of damaged cossettes and consequent damming and flooding of the machine, or commingling of juice and cossettes through their respective flow paths, or foaming of juice, which destroyed proper diffusion relationships. With the exception of Gazagne, and Figure 1 of Steffen, the countercurrent-concurrent systems all employed pressure devices to process the pulp at the point of transfer between cells. The two exceptions failed adequately to separate the juice and cossettes. Pressure treatments are not employed by the petitioner. Mr. Shafor, petitioner's

expert, testified that such treatments render the cossettes unfit for subsequent diffusion treatment (R. 243-47).

Certain of the prior patents showing countercurrent-concurrent systems also recirculated the juice and thus evidenced a complete lack of understanding of the requirements for satisfactory diffusion activity (Tab. 13, Ol. 8A Steffen).

All of the prior art patents, except Dobler, were cited by the Patent Office, and in referring to it, petitioner's expert witness, Mr. Shafor, said it should be "thrown out" as a reference because it does not disclose a countercurrent-concurrent system (R. 243). Mr. Shafor also said that he would "throw out" all other prior patents showing straight countercurrent systems insofar as the process is concerned, and all thereof that show "pulp presses" as references against the apparatus (R. 243-244). By this testimony, petitioner's own expert eliminated the patents to Rak, Neufeldt, Steffen (Fig. 2), Olier and Dobler.

### 3. The Novel Beet Diffusing Process and Machine Invented by Silver were Deliberately Appropriated by Petitioner.

In concurring with the District Court in finding that the combinations constituting the Silver inventions had been appropriated by petitioner, the Circuit Court summarized the evidence as follows:

> "We are not impressed with the contention that the Morton Battery follows the prior art and not the teachings of the Silver machine. The accused machine was designed by Whipple Vincent Morton who had been in the employ of Spreckles Sugar Company in California for many years. This battery consists of a series of horizontally disposed cells through which the cossettes and juice are moved in a countercurrent-concurrent flow by means of a scroll conveyor. At the end of each cell the cossettes are lifted out of the

juice and transferred to the next cell by means of a fork-like tool which rotates on the scroll shaft. The juice is screened at the end of the cell into a juice box and flows on from there by gravity to the next treatment stage. This screening and lifting of the cossettes from the juice for transfer provides the same effective drainage as the original Silver mechanism.[6] It is true that Morton, as did Silver, followed the prior art in the structural design of his battery as to different elements in a combination, but in addition each step in his process can be found in Silver's claims. He has eliminated vacuum filters and centrifuge or pulp presses between cells. He has established a method wherein exactly the same draining action before the transfer of the cossettes from cell to cell, occurs as in the Silver Battery. His process, like the Silver method, eliminated the clogging and injury to the cossettes which were the principal causes for the failure of the previous countercurrent batteries. He found in the Silver method a successful way to drain cossettes after each treatment and to transfer the juice from one cell to another to accomplish proper diffusion. The transfer of the cossettes from one cell to another and the rotation of the open scroll mechanism in the Morton machine effected an enforced submergence of the cossettes and an alternate upward and downward movement of them in the juice which furnished the necessary washing for effective diffusion. For many years prior to the construction of the accused machine, Morton, with all the prior art before him, had attempted to devise a successful continuous diffusion system and had obtained a patent[7] for such a machine which was not commercially successful. It was not until after he knew of Silver's inventions and was aware of their functional and commercial success that he was able to produce a successful battery. His battery performs the same work in substantially the same manner and accomplishes the same results as the Silver battery. This constitutes infringement." (R. 367-368)

It is significant that Morton, who designed petitioner's battery, on his earlier effort to produce a machine, avoided the countercurrent-concurrent system but, rather, undertook to make workable the straight countercurrent type of mechanism. (See footnote 2, R. 360; also footnote 7, R. 368.) Furthermore, Silver himself produced the scroll type of machine before Morton designed the Morton Battery (R. 74-76, 119). It is also significant that Morton did not succeed in devising a commercial machine until after he had knowledge of Silver's successful inventions (R. 331).

## ARGUMENT.

### I. PETITIONER HAS SHOWN NO REASONS SUFFICIENT TO WARRANT ISSUANCE OF THE WRIT.

The true measure of this controversy is factual. Silver made inventions of great merit and petitioner copied them. Petitioner now seeks certiorari to have the basic issues of invention, anticipation, and infringement retried by this Court after those issues have been established by concurrent findings of two lower courts. Even the attacked rulings of the Circuit Court construing the patents in suit are founded upon the factual context of these inventions and these patents.

The case presented comes squarely within the ruling of this Court in *General Talking Pictures Corporation* v. *Western Electric Co.*, 304 U.S. 175-178-179 (1938) where it was said:

> "Granting of the writ would not be warranted merely to review the evidence or inferences drawn from it. * * * Moreover, the decision on this point rests on concurrent findings. They are not to be disturbed unless plainly without support. * * * There is evidence to support them. Nor would the writ be granted to review questions of anticipation and invention that petitioner argues, for as to them, there is no conflict between decisions of circuit courts of appeals."

See also *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U.S. 405, 416 (1908)

Moreover, the present controversy does not possess the public interest which this Court has invariably required in its sparing exercise of the certiorari jurisdiction. This

jurisdiction is granted, as stated by this Court in *Magnum Import Company, Inc.* v. *Coty*, 262 U.S. 159, 163 (1923):

> "* * * to bring up cases involving questions of importance which it is in the public interest to have decided by this court of last resort. The jurisdiction was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing."

All of the patent law issues reduce, upon examination, to mere factual disputes or narrow points of construction having no interest beyond the boundaries of this case. The very number of the questions on which review is sought shows that petitioner has confused the public interest with its own.

Petitioner here seeks to create a large public interest by pointing to the success of the inventions while later in its argument it characterizes the respondent's sales as "unimpressive" (Petitioner's brief 116).

## II. POINT-BY-POINT REFUTATION OF REASONS RELIED ON BY PETITIONER.

### 1.

**Refutation of Petitioner's First Reason (Petitioner's brief 84-86); There is no Conflict in Circuit Court Decisions and no Exceptional Basis for Certiorari:** As a general rule, this Court will not grant certiorari to review a patent case unless there is a conflict in the decisions of the Circuit Courts of Appeal. No such conflict exists in this case. Petitioner argues, however, that the circumstances of this case bring it within a limited and rarely implemented exception.

As stated by this Court in *Mackay Radio & Telegraph Co.* v. *Radio Corporation of America*, 306 U.S. 86 (1939)

the requisites of this exception are that—

1. The questions presented must be of real importance to the public as distinguished from the parties;
2. Validity and infringement of the patent must be doubtful; and
3. Future litigation in other Circuits must be improbable.

None of these three requisites has been established by petitioner.

**Lack of Public Importance:** Petitioner has completely failed to show any issue of public importance. Here is a controversy having only interest to the parties and involving only validity and infringement questions. This case falls in the category of all other patent cases where validity and infringement are the only questions involved. The respondent is not a supplier who dominates an industry, but, rather, is an inventor who only recently took it upon himself to solve a problem in the sugar beet field. He stands in the position of the ordinary inventor who seeks the reward afforded by the Patent System for his ingenuity. No public interest question can be found in these facts.

**Validity and Infringement of Patents are not Doubtful:** Petitioner seeks certiorari as to the process and machine claims of the two Silver patents which were unanimously held valid and infringed by all four judges of the two courts which passed upon them. The care with which the lower courts considered the evidence is apparent from a consideration of their decisions and findings. Their findings conclusively show that the fact questions have been resolved against the petitioner, and that petitioner's arguments and

contentions are unsound and without equity. Nowhere in the record is any doubt evidenced or expressed in regard to the conclusions on which the decisions of the lower courts rest.

The commercial success of Silver's inventions, as evidenced by the record and the fact that he was the first to produce a successful process and machine after a period of many years of trial and failure, support the conclusion that he has made meritorious inventions and that his patents are valid.

The finding of infringement is also made stronger by the fact that Morton himself failed to solve the problem until after he knew of Silver's successful inventions (R. 331).

**Litigation in Other Circuits Is not Improbable**: Petitioner contends that the possibility of future litigation is remote (Petitioner's brief, pp. 84-86) but the cases on which it relies, with one exception, involves concentration in a single circuit of the entire industry to which the patent related. The industry in the *Mackay Radio & Telegraph Co. Case* was "the business of world wide public radio communication" (see 306 U.S. at p. 89) in which petitioner was respondent's sole competitor.

These cases have no application to the entirely different situation existing in the present case. No such concentration of the sugar beet industry or the sugar beet machinery industry—geographical or otherwise—is established by petitioner's record citations (Petitioner's brief p. 48). On the contrary, the record affirmatively shows that the sugar beet industry is distributed throughout the Eighth, Ninth and Tenth Circuits, and it is a matter of general knowledge that the industry extends throughout other Circuits in the

United States. It is also a matter of general knowledge that machinery and equipment companies, able in all respects to produce beet diffusion machines, are distributed throughout the entire United States. (R. 50-51)

It is true that the Appellate Court found (R. 360) that the Silver machine and the accused machine are the only diffusers which have thus far replaced the "Robert Battery" in the United States, but there is no evidence that respondent is now or likely to be free from competition. It cannot be argued with persuasion that competition can exist only if the Silver inventions are employed. In fact, the record shows that the Berge battery is now considered to be a successful machine and employs only the straight countercurrent flow system (See footnote, R. 360).

The cost of the machine and the effect of granting injunctive relief are inherent in many patent cases, and these circumstances alone fail to bring the facts of this case within the realm of the exceptions of the decisions of this court for granting writs in the absence of a conflict of decisions.

2.

**Refutation of Petitioner's Second Reason (Petitioner's brief 87-117); There Are No Important Patent Questions Decided Contrary to This Court's Decisions:** Under this section of petitioner's brief, there are eight subheadings, each of which is addressed to a particular aspect of the many factual considerations involved in the validity and infringement issues. Petitioner's arguments throughout, however, reflects its unwillingness to accept the clear findings of the two lower courts holding that (a) Silver did not disclaim processes and machines employing horizontal cells or, in other words, that there is no file wrapper

estoppel; and (b) that Silver's patents cover true combination inventions, not taught by the prior patents, which cannot be invalidated by dissection and a piecemeal attack on the separate elements standing alone.

1. **Petitioner's First Patent Law Point (Petitioner's Brief 87-97); Respondent Did Not Disclaim Horizontal Cells:** It is first said that Silver disclaimed horizontal cells, but as already shown the term "up and down courses" clearly referred to the path of movement of the cossettes and did not characterize the disposition of the cells. Further, both courts concluded this contention was entirely without merit when it was noted that Silver, in the specification of his first patent, said:

> " * * * it will be understood that the process also may be performed in cells disposed horizontally with a positive or gravity circulation of liquid employed." (Tab 11, Silver Ex. A, p. 2, Col. 1, 65-68.)

Besides, Silver proceeded to make a horizontal machine before acquiring any knowledge of Morton's activities (R. 119) showing that he fully contemplated machines having horizontal cells as well as those having vertical cells.

2. **Petitioner's Second Patent Law Point (Petitioner's brief 97-103); Courts Below Properly Construed the Claims of Silver's Patents:** Petitioner erroneously charges that the Circuit Court, when determining the nature of Silver's inventions, did nothing more than analyze the problem. The Court's decision, and especially the part thereof quoted in petitioner's brief, provides a complete refutation of petitioner's contention. Both courts found that Silver combined the countercurrent-concurrent type of system with an enforced submergence of cossettes by providing an up and down course of movement in each cell and then

combined these features with *draining* at the point of transfer between cells. This was the combination which produced success, which was not shown in the prior art, and which was employed by petitioner in its "Morton Battery".

At pages 102 and 103 of its brief, petitioner criticises the findings of fact and conclusions of law entered by the trial court on the grounds that they were drafted by respondent's counsel and reflect counsel's views rather than those of the court. The findings, however, were based on the Court's prior opinion and hence the regret that the lower court's opinion was somehow omitted from the record. Reference to that opinion, however, will show beyond doubt that the findings entered are those of the Court.

It is entirely clear from the findings of both courts that the "enforced submergence" referred to in petitioner's argument (Petitioner's brief 98) is the function of the "alternate downward and upward courses of cossette travel" which is included as a step in the process claims (see cl. 2 of Silver's first patent, Tab 11, Silver Ex. A). Also that the elimination of the juice "without mutilating the cossettes" is merely the function of "draining" also included as a step in the process. Whereas these functions were discussed by the court as throwing light on the significance of the steps, it is entirely proper to omit specific reference to such functions in the claims themselves.

3. **Petitioner's Third Patent Law Point (Petitioner's brief 103-105); Silver Invented New and Patentable Combinations:** This point has already been fully answered (pp. 5-8 above). Here again, the petitioner is urging that the prior art, which admittedly shows only the separate elements, one here and one there, should be considered as anticipations of the new combinations. No prior patent, however, combined the elements to produce a workable process or machine.

4. **Petitioner's Fourth Patent Law Point (Petitioner's brief 105-111); Claims 7, 9, 10, and 11 of Silver's Second Patent Are Not Invalid on the Ground of Double Patenting:** Petitioner is here urging invalidity of process claims 7, 9, 10, and 11 of Silver's second patent (Tab 12, Silver Ex. B) on the grounds of double patenting. Its argument, however, is based on the fallacious assumption that the subject-matter of the process claims of the second patent are directed to subject-matter disclosed in the first patent. This, however, is not the fact. The improvement claimed could not have been claimed in the first patent, as there was no disclosure in that patent to support such claims. That this is so, can readily be determined from a comparison of the patents themselves. The improved juice outlet is shown at "S" in Fig. 5 of the drawing of the second patent. No such outlet is found in the drawing or specification of the first patent (See Tab 11, Silver Ex. A).

5. **Petitioner's Fifth Patent Law Point (Petitioner's brief 111-114); Silver's Claims Were Properly Held to be Valid Combination Claims:** This point already has been fully answered. Both courts below recognized that the inventions consisted of a new combination of elements which produced a new and unexpected result, and that no claim was made to the various elements or steps as such. The fact that the elements may have been individually old does not detract from the patentability of the combination as such. The Circuit Court **properly held—**

> "Invalidity of a combination patent may not be established by showing that the different elements making up the combination are old" (R. 365).

This Court has held to the same effect in many cases—

> *Leeds and Catlin* v. *Victor Talking Machine Co.*, 213 U.S. 325, 332;

*Expanded Metal Co.* v. *Bradford,* 214 U.S. 366, 381;
*Loom Co.* v. *Higgins,* 105 U.S. 580, 591;
*Seymour* v. *Osborne,* 78 U.S. 516, 555.

6. **Petitioner's Sixth Patent Law Point (Petitioner's brief 114-115); The Morton Machine and Its Use Does Infringe the Silver Patents:** Argument on this point is believed to be unnecessary. Petitioner has failed utterly to show wherein the accused machine differs in any essential respect from the combination set forth in the claims in issue. The Circuit Court in concurrence with the lower court found that Morton, like Silver, combined the countercurrent-concurrent flow system employing a plurality of connected cells, with alternate *downward and upward courses of the cossettes* and *draining* of the cossettes at the point of transfer between cells, and further that the Morton battery—

> "performs the same work in substantially the same manner and accomplishes the same results as the Silver battery" (R. 368).

7. **Petitioner's Seventh Patent Law Point (Petitioner's brief 115); Prior Art Patents Do Not Anticipate Silver's Inventions:** Petitioner erroneously assumes that the two lower courts disregarded the disclosures of the prior patents because they had not been commercially used. This is not the fact, as can be readily determined from the findings of the courts below. It was not because they had not been commercially used that they were without significance as anticipations, but, rather, because not one of them disclosed a workable combination of steps or elements. The reason they were not used commercially is found in the fact that each and every one of them failed to provide a solution to the problem or teach a procedure which would

provide continuous diffusion such as would displace the "Robert Battery" in the industry.

8. **Petitioner's Eighth Patent Law Point (Petitioner's brief 116); Silver's Inventions Have Enjoyed Exceptional Commercial Success:** Only on rare occasions are courts called upon to pass upon patents covering inventions which have enjoyed the remarkable commercial success which characterizes the Silver inventions. The fact that Silver has produced the first commercial continuous diffuser employed in this country, and the further fact that a tremendous improvement in the treatment of beets with a marked saving in operating costs were realized, are undisputed. Further, there is no question about the fact that prior to Silver's inventions, the Robert Battery, which is a batch type of operation, has remained the standard equipment of the world for a period in excess of one hundred years, notwithstanding repeated efforts of numerous technical workers in Europe and this country to devise a continuous diffuser. In addition, there is no dispute about the fact that immediately upon the completion of the Silver inventions his battery displaced the Robert Battery in numerous beet plants in this country and Canada. Petitioner has attempted to minimize the importance of this success, but it is submitted that the record speaks for itself. (R. 27, 30, 364)

## CONCLUSION.

The writ should not issue.

Respectfully submitted

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